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10/023,438	12/18/2001	Niko Eiden	944-003.123	2313

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EXAMINER
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NGUYEN, DAVID Q

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/023,438

**Applicant(s)**

EIDEN ET AL.

**Examiner**

David Q Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9 and 12-15 is/are rejected.
- 7) ☒ Claim(s) 5, 10-11 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 08/20/04 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The mode guard tag recited in claim 1 controls editing of a picture, editing in the sense of actually altering the content of the picture) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument, applicants agree: "None correspond to the mode guard tag recited in claim 12."

Examiner respectfully disagrees because Feldis, III discloses resolution tag, cropping tag, red-eye removal tag. These tags have the same functions as the mode tag for enabling editing of the picture so as to alter the content of at least a portion of the picture, recited in claim 12 (see page 3, paragraphs 0032 to 0039).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Feldis, III (US 2003/0007078 A1).

Regarding claim 12, Feldis III discloses a method for use by a wireless terminal (see page 2, paragraph 0028) used in communicating pictures via a wireless communication system (see page 5, claims 15-16), the method comprising: a) an examination step, responsive to a picture, for examining the picture to determine whether the picture includes a predetermined tag (see page 3, paragraphs 0032-0039; paragraphs 0038-0039), for providing an indication of whether or not the picture includes the predetermined tag (see page 3, paragraphs 0032-0039; paragraphs 0038-0039); and a mode guard step, for enabling editing of the picture so as to alert the content of at least a portion of the picture, depending on the indication of whether or not the picture includes the predetermined tag (see page 3, paragraphs 0032-0039; paragraphs 0038-0039).

Regarding claim 13 and 14, Feldis III also discloses wherein in the mode guard step a user is allowed to edit the picture only if the picture includes the predetermined tag; wherein in the mode guard step, a user is not allowed to edit the picture if the picture includes the predetermined tag (see page 3, paragraphs 0032-0039; paragraphs 0038-0039).

Regarding claim 13 and 14, Feldis III also discloses comprising a step of displaying the predetermined tag so that it is visible to a user only if the user places the wireless terminal into a mode of operation allowing editing of an editable picture (see page 3, paragraphs 0032-0039; paragraphs 0038-0039).

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Regarding claim 15, Feldis III further comprising a step of displaying the predetermined tag so that it is visible to a user only if the user places the wireless terminal into a mode of operation allowing editing of an editable picture (see paragraph 0032).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Simons et al (US 6320595) in view of Feldis, III (US 2003/0007078 A1).

Regarding claim 1, Simons et al disclose a wireless terminal for communicating pictures via a wireless communication system (see abstract), the wireless terminal comprising: a) a picture manager (CPU 26) responsive to signals indicating pictures for displaying the pictures (see col. 5, lines 49-to col. 6, lines 37; col. 5, lines 49-61); and a picture source (store 38), for providing the signals indicating pictures along with optional associated text, responsive to the signals indicating the edited and non-edited pictures (see col. 5, lines 49-to col. 6, lines 37; col. 5, line 62 to col. 6, lines 8). Simons et al are silent to disclose each of pictures are either editable or non-editable as indicated by a predetermined tag embedded in the picture, and for examining each of the pictures to determine whether each of the pictures includes the predetermined tag and so is either editable so as to alert the content of at least a portion of the picture or is non-editable,

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depending on whether a tag in a picture is pre-agreed to signify that the picture is editable or is non-editable, for providing signals indicating edited and non-edited pictures. However, Feldis III discloses each of pictures are either editable or non-editable as indicated by a predetermined tag embedded in the picture, and for examining each of the pictures to determine whether each of the pictures includes the predetermined tag and so is either editable so as to alert the content of at least a portion of the picture or non-editable, depending on whether a tag in a picture is pre-agreed to signify that the picture is editable or is non-editable, for providing signals indicating edited and non-edited pictures (see explanation in claim 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Feldis III to Simons et al so that a company that provides a picture advertising a product or service want a user to be prevented from editing the picture.

Regarding claim 2-4, the wireless terminal of Simons et al in view of Feldis III also discloses wherein the picture manager will not enable editing a picture if the picture includes the predetermined tag (see page 3, paragraphs 0032-0039; paragraphs 0038-0039 of Feldis III); wherein the picture manager will enable editing a picture only if the picture includes the predetermined tag (see page 3, paragraphs 0032-0039; paragraphs 0038-0039 of Feldis III); wherein the predetermined tag is visible to a user of the wireless terminal only if the wireless terminal is placed by the user into a mode of operation allowing editing of an editable picture (see page 3, paragraphs 0032-0039; paragraphs 0038-0039 of Feldis III).

4. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simons et al (US 6320595) in view of Feldis, III (US 2003/0007078 A1) and further in view of Song (US 2002/0090068).

Regarding claims 6-9, the wireless terminal of Simons et al in view of Feldis III also discloses a system comprising a wireless terminal for communicating pictures via a wireless communication system (see claims 15-16 of Feldis III). They do not mention a base station transceiver for providing communication between the wireless terminal and other communication devices. However, Song mentions a base station transceiver for providing communication between the wireless terminal and other communication devices (see abstract, using base station transceiver to transmit image is well known in the art). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Song to Feldis III and Simons et al so that users can send image each others using wireless communication system.

***Allowable Subject Matter***

5. Claim 5, 10-11 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 5 and 10-11, the wireless terminal of Simons et al in view of Feldis III discloses all limitations of claim 1. But they do not mention a memory device and wherein the picture manager automatically saves downloaded pictures including the predetermined tag in a different location in the memory device from where the picture manager saves downloaded pictures not including the predetermined tag, as specified in claim 5.

Regarding claim 16, Feldis III discloses a method comprising all of the limitations as claimed in claim 12. Feldis III is silent to disclose wherein in the examination step, a

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downloaded picture having the predetermined tag is automatically saved in a different location in a memory device from where a downloaded picture not including the predetermined tag is saved, as specified in claim 16.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 703-605-4254. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 703-308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN

David Nguyen

  
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